

REMARKS:

Claims 1-48 are currently pending in the application. Claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,600,789 to Parker et al. ("Parker") in view of U.S. Patent No. 6,804,709 to Manjure et al. ("Manjure"). Claims 3, 5-7, 19, 21-23, 34, 36-38, and 48 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Manjure and in further view of U.S. Patent No. 6,766,481 B2 to Estep et al. ("Estep").

A Final Office Action in the subject Application was mailed to the undersigned on 28 July 2005, which provides for a response period ending 28 October 2005. The Applicant filed an Amendment After Final on 30 August 2005, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 29 September 2005. The Advisory Action stated that the proposed Amendments filed on 30 August 2005 will not be entered because the newly added limitation in claims 1, 17, 32, and 47 regarding in a test results database raise new issues that require further consideration and/or search. (29 September 2005 Advisory Action, Pages 1-2).

The Advisory Action further stated that for the purpose of appeal, the proposed amendments will not be entered and the status of the claims are: claims 1-48 rejected. (29 September 2005 Advisory Action, Page 1). The Applicant respectfully reiterates here the arguments set forth in the Amendment After Final filed on 16 August 2005, as if fully set forth herein.

By this Amendment, independent claim 48 has been canceled without prejudice and independent claims 1, 17, 32, and 47 and dependent claims 12-14, 28-30, and 43-45 have been amended to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicant reserves the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1, 12-14, 17, 28-30, 32, 43-45 and 47-48. No new matter has been added.

PREVIOUS REJECTION UNDER 35 U.S.C. § 112:

The Applicant thanks the Examiner for withdrawing the rejection to claims 15, 31, and 46 under 35 U.S.C. § 112.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Manjure. Claims 3, 5-7, 19, 21-23, 34, 36-38, and 48 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Manjure and in further view of Estep.

Although the Applicant believes claims 1-48 are directed to patentable subject matter without amendment, the Applicant has canceled independent claim 48 without prejudice and amended independent claims 1, 17, 32, and 47 and dependent claims 12-14, 28-30, and 43-45 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that Parker or Manjure either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47. The Applicant further submits that Parker, Manjure, or Estep either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 5-7, 19, 21-23, 34, and 36-38. Thus, the Applicant respectfully traverses the Examiners obvious rejection of claims 1-47 under 35 U.S.C. § 103(a) over the proposed combination of Parker, Manjure, or Estep either individually or in combination.

For example, with respect to amended independent claim 1, this claim recites:

A system for distributed automated software graphical user interface (GUI) testing, comprising:

a centralized test queue operable to store a plurality of software GUI test instances to be executed by a plurality of parallel, distributed test execution computers, each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed;

a client controller associated with each distributed test execution computer; and

a test server engine operable to, for each distributed test execution computer:

receive a request for a software GUI test instance from a particular distributed test execution computer in response to completion of a preceding software GUI test instance by the particular distributed test execution computer;

retrieve a software GUI test instance from the test queue in response to the request from the particular distributed test execution computer;

communicate the retrieved software GUI test instance to the particular distributed test execution computer for execution in parallel against a particular client-server combination using a testing component supported by the particular distributed test execution computer, the testing component operable to perform automated software GUI testing and to produce test results for such testing for communication to the test server engine;

receive a test result for the software GUI test instance from the client controller associated with the particular distributed test execution computer in response to execution of the software GUI test instance; and

store the received test result in a test result database, for reporting to one or more users. (Emphasis Added).

Amended independent claims 17, 32, and 47 recite similar limitations. Parker or Manjure either individually or in combination, fail to disclose, teach or suggest each and every limitation of amended independent claims 1, 17, 32, and 47.

The Applicant has reviewed Parker in detail, particularly looking for a distributed automated software graphical user interface testing system, relied upon by the Examiner. (28 July 2005 Office Action, Pages 2-6). However, Parker fails to disclose, teach, or suggest several of the limitations recited by amended independent claim 1. Thus, the Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Parker.

The Applicant respectfully submits that Parker has nothing to do with amended independent claim 1 limitations regarding a system, method, or even software for a distributed automated software graphical user interface testing comprising: (1) a centralized test queue operable to store a plurality of software graphical user interface test instances to be executed by a plurality of parallel, distributed test execution computers; and (2) a test server engine operable to receive requests, retrieve requested software GUI test instances, communicate the software GUI test instances for execution in parallel, receive test results, and store test results in a test results database. Rather Parker discloses a system for automated GUI interface testing including a test script, a test executive, and a test driver. (Column 3, Line 67 through Column 4 Line 13). Parker does not disclose, teach, or suggest a test script, or even a test driver that is capable of storing a plurality of software graphical user interface test instances to be executed in parallel, by multiple distributed test execution computers.

Furthermore, Parker does not disclose, teach or suggest that the test script is in anyway associated with the centralized test queue of the subject Application, since the test script of Parker is not even directed towards GUI specific references, but instead is directed towards GUI-independent references. (Column 4, Lines 1-12). In fact, Parker teaches away from the claimed invention because the test executive of Parker is located on a particular machine, whether the machine is the particular machine (Figure 4) or even another machine (Figure 15). However, the Examiner asserts that Parker discloses test scripts that are in someway inherent to the centralized test queue of Applicant's claimed invention. (28 July 2005 Office Action, Page 21). The Applicant respectfully traverses the Examiner's assertions regarding the inherent features of Parker. Thus Parker cannot provide for a centralized test queue since there is no centralization associated with any of the particular machines disclosed in Parker.

The Applicant further submits that Parker fails to disclose a client controller associated with each distributed test execution computer and a test server engine operable for each distributed test execution computer to: (1) receive a request for the software graphical user interface test instance; (2) retrieve the requested software graphical user interface test instance from the centralized test queue; (3) communicate

the retrieved software graphical user interface test instance for execution in parallel on multiple distributed test execution computers; (4) receive a test result for each executed software graphical user interface test instance from the multiple distributed test execution computers, and (5) store the received test results in a test results database, for reporting to one or more users. Rather Parker discloses a test executive that passes a GUI specific command to a test driver, which in turn performs action specified in the test script command. Although the test executive and the test driver of Parker are collectively referred to as a test tool, Parker does not disclose, teach, or suggest that this test tool is associated with a client controller or is even capable of: (1) receiving a request for the software graphical user interface test instance; (2) retrieving the requested software graphical user interface test instance from the centralized test queue; (3) communicating the retrieved software graphical user interface test instance for execution in parallel on multiple distributed test execution computers; (4) receive a test result for each executed software graphical user interface test instance from the multiple distributed test execution computers; and (5) storing the received test results in a test results database, for reporting to one or more users. Thus, Parker cannot provide a test server engine operable for each distributed test execution computer, since Parker does not even provide for a test executive, test driver, or even a test tool that is in anyway associated with the parallel execution of software graphical user interface test instance's or the storing of received test results in a test results database.

The Applicant still further submits that the Office Action acknowledges, and Applicant agrees, that Parker fails to disclose the emphasized limitations of amended independent claims 1, 17, 32, and 47. Specifically, the Examiner acknowledges that Parker fails to disclose: (1) a centralized test queue operable to store a plurality of software graphical user interface test instances to be executed by a plurality of parallel, distributed test execution computers; and (2) each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed. (28 July 2005 Office Action, Page 6). However, the Examiner asserts that the cited portions of Manjure disclose the acknowledged shortcomings in Parker. The Applicant respectfully

disagrees. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in Manjure.

The Applicant respectfully submits that Manjure has nothing to do with amended independent claim 1, 17, 32, or 47 limitations regarding a centralized test queue operable to store a plurality of software graphical user interface test instances to be executed by a plurality of parallel, distributed test execution computers, each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed. Rather Manjure discloses a system and method for implementation of a remote access protocol. (Abstract). Manjure does not disclose, teach, or suggest that the implementation of a remote access protocol is in anyway analogous with a distributed automated software graphical user interface testing. Although Manjure discloses the formation of a client server connection, Manjure teaches this formation is limited to client server connections only under a remote access protocol. (Column 4, Line 66 though Column 5 Line 12). Thus, Manjure cannot provide a centralized test queue operable to store a plurality of software graphical user interface test instances to be executed by a plurality of distributed test execution computers, wherein each distributed test execution computer comprises a client platform and is coupled to one or more server platforms, collectively providing a plurality of client-server combinations against which the software graphical user interface test instances may be executed, since Manjure does not even provide for a centralized test queue, a software graphical user interface test instance, a distributed test execution computer, a client platform, or a client-server combination against which the software graphical user interface test instances may be executed.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Parker and Manjure. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art, at

the time of the invention to include information regarding various network platform combinations in a GUI software test environment, including a test queue, as that allows for more fully testing of the software. (28 July 2005 Office Action, Page 7). The Applicant respectfully disagrees.

The Applicant further submits that these purported advantages relied on by the Examiner are nowhere disclosed, taught, or suggested in Parker or Manjure, either individually or in combination. The Examiner asserts that the cited portions of Manjure provide support for these purported advantages. The Applicant respectfully directs the Examiner's attention to the cited text of Manjure, which states:

Prior to the invention, there has been no testing system or method available that enables automated testing of the implementation of a remote access protocol, such as the point-to-point (PPP) protocol, in network servers and/or clients, in a flexible, efficient, and controlled manner. (Column 2, Lines 5-10). (Emphasis Added).

The Applicant respectfully submits that the Examiner has mischaracterized Manjure. The above-cited text of Manjure merely describes a deficiency in the area of remote access services, and in particular remote access protocols, to enable different computers to establish communication connections with each other. (Column 1, Lines 17-28). The remote access services of Manjure provide for a remote access protocol, the point-to-point (PPP) protocol, which is actually a set of industry standard protocols that enables remote access solutions allowing two computers to agree upon how they should conduct subsequent communications over a network. (Column 1, Lines 24-37). Manjure fails to teach, suggest or even hint at a centralized test queue operable to store a plurality of software graphical user interface test instances to be executed by a plurality of parallel, distributed test execution computers, each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Parker and Manjure to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that it would have been obvious "to include information regarding various network platform combinations in a GUI software test environment, including a test queue" and that "this allows for more fully testing of the software" does not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* at 1343-44. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Parker or Manjure either individually or in combination.

The Applicant further submits that the Office Action acknowledges, and Applicant agrees, that Parker or Manjure, either individually or in combination, fail to disclose the emphasized limitations of dependent claims 3, 5-7, 19, 21-23, 34, and 36-38. Specifically, the Examiner acknowledges that Parker and Manjure fail to disclose: (1) a testing component associated with a test server engine, supported by the particular distributed test execution computer and operable to perform automated software graphical user interface testing and to produce test results for such testing for communication to the test server engine, is a commercial off-the shelf product (28 July 2005 Office Action, Page 14); (2) a test server engine operable to generate a test results web page comprising test results for a plurality of software graphical user interface test instance and a web server operable to communicate the test results web page for display on a user system to provide substantially real-time test results reporting (28 July 2005 Office Action, Pages 14-16); (3) the test results web page comprising

consolidated results for a particular client platform (28 July 2005 Office Action, Pages 16-17); and (4) the test server engine operable to receive a user request to execute an instance of a particular software graphical user interface test and insert it into the test queue according to the user request. (28 July 2005 Office Action, Pages 17-18). However, the Examiner asserts that the cited portions of Estep disclose the acknowledged shortcomings in Parker and Manjure. The Applicant respectfully disagrees. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in Estep.

The Applicant respectfully submits that Estep has nothing to do with dependent claim 3, 5-7, 19, 21-23, 34, and 36-38 limitations regarding: (1) the testing component supported by the particular distributed test execution computer and operable to perform automated software graphical user interface testing and to produce test results for such testing for communication to the test server engine, is a commercial off-the shelf product; (2) a test server engine operable to generate a test results web page comprising test results for a plurality of software graphical user interface test instance and a web server operable to communicate the test results web page for display on a user system to provide substantially real-time test results reporting; (3) the test results web page comprising consolidated results for a particular client platform; and (4) the test server engine operable to receive a user request to execute an instance of a particular software graphical user interface test and insert it into the test queue according to the user request. Rather Estep discloses a process for testing commercial, off-the-shelf software products to determine functionality for specific criteria and presenting decision-making information in an interactive web-based repository. (Column 1, Lines 13-17). Estep merely includes the presentation of decision-making information but fails to disclose, teach, or suggest that each distributed test execution computer comprises a client platform and is coupled to one or more server platforms, collectively providing a plurality of client-server combinations against which the software graphical user interface test instances may be executed.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Parker, Manjure, or Estep, either individually or in combination, with respect to dependent claims

3, 19, and 34. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Parkers GUI testing to include commercial off-the-shelf software. (28 July 2005 Office Action, Page 14).

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Parker, Manjure, or Estep, either individually or in combination. The Examiner asserts that one of ordinary skill in the art, at the time of the invention, would have been motivated to modify Parker, Manjure, and Estep in order to save time and money in software development. (28 July 2005 Office Action, Page 14). The Applicant respectfully disagrees. The Applicant respectfully requests the Examiner to point to the portions of Parker, Manjure, or Estep which contain the teaching, suggestion, or motivation to combine Parker, Manjure, or Estep for the Examiner's stated purported advantage. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Examiner asserts that the cited portions of Estep provide support for motivation to combine the references as proposed. (28 July 2005 Office Action, Page 14). The Applicant respectfully disagrees. The Applicant respectfully directs the Examiner's attention to the cited text of Estep, which states:

This invention relates to systems and processes for testing and evaluating software, and in particular, to a process for testing commercial, off-the-shelf software products to determine functionality for specific criteria and presenting decision making information in an interactive web-based repository. (Column 1, Lines 12-17). (Emphasis Added).

Therefore, the art needs a method for providing users with the necessary data to readily determine whether a particular piece of software will perform a specific function hereby fitting within the context of the users' specific application(s). (Column 1, Lines 55-60). (Emphasis Added).

The Applicant respectfully submits that the Examiner has mischaracterized the cited text of Estep. The above-cited text of Estep merely states a field of technology in which Estep is related; in other words, Estep is related to the field relating to testing commercial off-the-shelf software products. (Column 1, Lines 12-17). Furthermore, the above-cited text of Estep merely states a need in the field of technology for providing users with the necessary data to readily determine whether a particular piece of commercially off-the-shelf software will perform a specific function. (Column 1, Lines 55-60). Estep fails to teach, suggest, or even hint at any motivation for the purpose of combining the references to read on dependent claim 3, 19, and 34 limitations regarding the testing component supported by the particular distributed test execution computer and operable to perform automated software graphical user interface testing and to produce test results for such testing for communication to the test server engine, is a commercial off-the shelf product.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1343-44. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Parker, Manjure, and Estep to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that it would have been obvious "to have modified Parkers GUI testing to include commercial off the shelf software as it is well known in the art" and that "an effective reuse of software, thereby saving time and money in software development" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Parker, Manjure, or Estep either individually or in combination.

In addition, the Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Parker, Manjure, or Estep, either individually or in combination, with respect to dependent claims 5-7, 21-23, and 36-38. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Parker/Manjure test executive to produce test results on a web page. (28 July 2005 Office Action, Page 16).

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Parker, Manjure, or Estep either individually or in combination. The Examiner asserts that one of ordinary skill in the art, at the time of the invention, would have been motivated to modify Parker, Manjure, and Estep in order to publish information, effectively and inexpensively providing real time details to customers. (28 July 2005 Office Action, Page 16). The Applicant respectfully disagrees. The Applicant respectfully requests the Examiner to point to the portions of Parker, Manjure, or Estep which contain the teaching, suggestion, or motivation to combine Parker, Manjure, or Estep for the Examiner's stated purported advantage. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Examiner still asserts that the cited portions of Estep provide support for motivation to combine the references as proposed. (28 July 2005 Office Action, Page 16). The Applicant respectfully disagrees. The Applicant respectfully directs the Examiner's attention to the cited text of Estep, which states:

This invention relates to systems and processes for testing and evaluating software, and in particular, to a process for testing commercial, off-the-shelf software products to determine functionality for specific criteria and presenting decision making information in an interactive web-based repository. (Column 1, Lines 12-17). (Emphasis Added).

Therefore, the art needs a method for providing users with the necessary data to readily determine whether a particular piece of software will perform a specific function hereby fitting within the context of the users' specific application(s). (Column 1, Lines 55-60). (Emphasis Added).

The Applicant respectfully submits that the Examiner has mischaracterized the cited text of Estep. The above-cited text of Estep merely states the invention is related to a process for presenting decision making information in an interactive we-based repository. (Column 1, Lines 12-17). Furthermore, the above-cited text of Estep merely states a need in the art for providing users with the necessary data to readily determine whether a particular piece of software will perform a specific function. (Column 1, Lines 55-60). Estep fails to teach, suggest, or even hint at any motivation for the purpose of combining the references to read on dependent claim 5-7, 21-23, and 36-38 limitations regarding: (1) a test server engine operable to generate a test results web page comprising test results for a plurality of software graphical user interface test instance and a web server operable to communicate the test results web page for display on a user system to provide substantially real-time test results reporting; (2) the test results web page comprising consolidated results for a particular client platform; and (3) the test server engine operable to receive a user request to execute an instance of a particular software graphical user interface test and insert it into the test queue according to the user request.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Parker, Manjure, and Estep to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that it would have been obvious "to have modified Parker/Manjure test executive to produce test results on a we page" and that "this is a well known manner to publish information, effectively and inexpensively providing real time details to customers" do not

adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* at 1343-44. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Parker, Manjure, or Estep either individually or in combination.

With respect to dependent claims 2-16, 18-31, and 33-46: claims 2-16 depend from amended independent claim 1; claims 18-31 depend from amended independent claim 17; and claims 33-46 depend from amended independent claim 32. As mentioned above, each of amended independent claims 1, 17, 32, and 47 are considered patentably distinguishable over Parker, Manjure, or Estep, either individually or in combination. Thus, dependent claims 2-16, 18-31, and 33-46 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant submits that claims 1-47 are not rendered obvious by the proposed combination of Parker, Manjure, and Estep. The Applicant further submits that claims 1-47 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-47 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-47 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because the Amendment After Final was filed within two (2) months of the date of the Final Office Action and this Amendment is filed prior to the ending of the response period 28 October 2005 of the Final Office Action mailed on 28 July 2005, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

10/11/05
Date


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